



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,353	02/10/2004	Phillip Frederick	10557/293163	1160
30559	7590	03/10/2009		
DIANA HOUSTON SMITH & NEPHEW, INC. 1450 BROOKS ROAD MEMPHIS, TN 38116			EXAMINER SWIGER III, JAMES L	
			ART UNIT	PAPER NUMBER
			3775	
			MAIL DATE	DELIVERY MODE
			03/10/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/775,353

**Applicant(s)**

FREDERICK ET AL.

**Examiner**

JAMES L. SWIGER

**Art Unit**

3775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-5,8-10,12 and 25-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,8-10,12 and 25-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 1/9/2009.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/21/2008 has been entered.

### ***Claim Objections***

Claim 4 is objected to because of the following informalities: Claim 4 depends from a cancelled claim 2. For examination purposes, claim 4 will be considered to depend from claim 3. Appropriate correction is required.

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Applicant has not defined what is meant by a 'peripheral edge.'

The amendment filed 11/21/2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: applicant has not provided a description that the first portion of the generally dome-shaped exterior

surface of the hollow body occupies substantially less than half of the hollow body exterior surface.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 10 and 31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has not described how the first portion itself occupies substantially less than half of the hollow body exterior surface. Applicant has defined only that the teeth occupy substantially less than one half of the surface area.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-5, 8, 25-26, 27-28, 35 and 37-38 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has not defined what is meant by a peripheral edge forming at least a portion of a first arc. For

examination purposes, the peripheral edge will be interpreted as noted below in the annotated drawing (PE).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

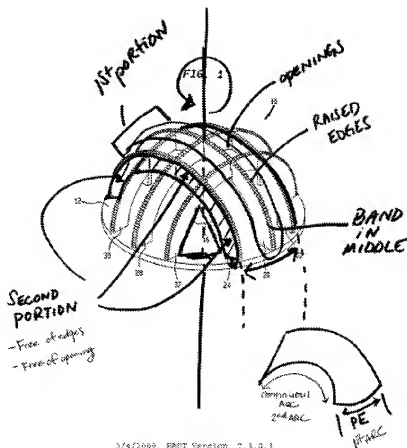
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-5, 8-10, 12, 25-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Frieze et al. (US patent 5,755,719) hereafter Frieze. Frieze discloses a reamer for reaming bone or a cartilage having a hollow body (or dome, or portion, and further considered at least spheriodial, see view in Fig. 7), comprising an exterior surface (outer dome shape 90) having a first portion and a second portion that forms a planar surface (see annotated drawing below), wherein the first portion of the exterior surface is dimensioned substantially as an axis of rotation (see annotated drawing, the axis is drawn where it rotates to ream the bone), further comprising a plurality of raised edges (see ridges in fig. 1), which are capable of cutting bone, cartilage, or a combination thereof, and wherein Frieze further comprises a plurality of openings (see annotated) where the fragments can pass through. Frieze further discloses an at least one second portion (see annotated drawing) that forms a side and a generally planar exterior surface of the hollow body, and wherein this side portion is free of any raised edges. The side as noted in the drawing is free of any raised edges. The portion noted as the side, is also considered free of openings for the passing of fragments.

Additionally, this second portion, as it partially encloses the limits of the interior of the hollow reamer body (and wherein the holes from the first portion are considered part of the depth where the various fragments may go), and thus is considered to "generally serve to maintain the fragments of bone or cartilage or the combination thereof."

The first portion further includes a peripheral edge, "PE," (shown as the bottom edge of the first surface, see annotated drawing and additional drawing in bottom right corner), that forms at least a portion of an arc (it is curved, following the shape of the domed surface), and wherein the first portion intersects with the at least one second portion (it is noted that there is a also a second portion on the other side with identical limitations), and wherein this second portion forms a second arc. This second arc extends continuously from where it meets the first arc formed by the PE, over to another point on the PE. See also additional drawing for reference.



1/4/2009, FIRST Version, 7.3.0.3

The at least one second portion is considered substantially parallel to a rotational axis, and also the two portions (facing one another) are considered parallel to one another. The raised edges as shown in the annotated drawing, may be considered to be confined to a band that straddles the middle portion of the generally dome-shaped surface. The raised edges that cross the longer band as noted, are part of a center area where they are confined. In terms of the first portion being less than half of the dome shaped surface, it appears that factoring the total cutting area yielded by the reamer, this first portion would be less than half of the total area of the exterior surface of the hollow body.

Further in regards to Frieze and the claims and the statements of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Frieze which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 3-5, 8-10, 12, 25-39 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES L. SWIGER whose telephone number is (571)272-5557. The examiner can normally be reached on M-F, 9am-5:30pm.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JAMES L. SWIGER/  
Examiner, Art Unit 3775  
/Eduardo C. Robert/  
Supervisory Patent Examiner, Art Unit 3733